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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,178	03/12/2004	Joe W. Ferguson	31132.237	8149

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HAYNES AND BOONE, LLP
901 MAIN STREET, SUITE 3100
DALLAS, TX 75202

EXAMINER

KIM, JOHN

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/799,178	Applicant(s) FERGUSON ET AL.	
	Examiner John Kim	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/26/04, 9/21/04, 3/22/05, 9/27/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 13-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on March 23, 2006.

Applicant's election with traverse of invention 1 (claims 1-12, 21-23) in the reply filed on March 23, 2006 is acknowledged. However no grounds have been claimed for traversal. A mere broad allegation that the requirement of election/restriction is in error and does not comply with the requirement of 37 CFR 1.111. Thus the required provisional election becomes an election without traverse

The requirement is still deemed proper and is therefore made FINAL.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1, 11, 12, 21 and 23 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-8, 22-24 of copending Application No.

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10/799835. Both applications claim an assembly with a distractor with a first and second arm, a first and second anchoring device (fastener), an attaching instrument, and a shaping (milling) instrument. Both inventions is for preparing an intervertebral disc space between a pair of vertebral bodies to receive a prosthesis. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Specification

The disclosure is objected to because of the following informalities: Examiner notes in the brief description, the figure heading for figure 7 is incorrect. Figure 7 only shows the anchoring device.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3, 4, 9, 21, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "the movement" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the movement" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "the movement" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "one of the apertures" in line 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "one of the fasteners" in line 2. There is insufficient antecedent basis for this limitation in the claim. Examiner notes that claim 9 might be depending from claim 8 rather than claim 7. For examination purpose, examiner will treat claim 9 to depend from claim 8. Appropriate correction is required.

Claim 21 recites the limitations "first and second vertebral bodies" in line 1-2, "the first vertebral body" in line 5-6, and "the second vertebral body" in line 9-10. There is insufficient antecedent basis for this limitation in the claim.

Claim 22 recites the limitation "the instrumentation guide" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 10, 21 rejected under 35 U.S.C. 102(e) as being anticipated by Bertagnoli (US Pat App Pub 2005/0021040) (in the IDS).

In regards to claim 1 and 21, Bertagnoli discloses an assembly having a distractor (5) with a first (11) and second (12) distraction arm (in parallel relation), and a first and second anchoring device (35). (see figures 1 and 3). In regards to claim 2-4, the first anchoring device can move in a sagittal, pivotal, or linear movement. In regards to claim 5 and 21, the first anchoring device (35) has a pivot mechanism (39) and first distracting arm (11 or 12) has a pin (40). It is noted that a pin is a slender usually cylindrical piece of wood or metal for holding or fastening parts together. In regards to claim 6, the first anchoring device has an elongated shaft (35, figure 3) and first distracting arm (11 or 12) has an elongated recess (19 or 23). In regards to claim 10, the first anchoring device has an adjustable seat (36).

It is noted that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429,1431-32. (see also MPEP 2114, R-1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-9, 11 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertagnoli (US Pat App Pub 2005/0021040) (in the IDS) in view of Kim (US Pat App Pub 2003/0055430) (in the IDS).

In regards to claims 7-9 and 22, Bertagnoli discloses the claimed invention except for having an alignment guide. Kim discloses a distractor device with an alignment guide(42, figure 11 a-c). Kim shows the alignment guide is placed between the first and second anchoring device, has a pair of apertures, and a restraint pin from the first anchoring device (38, Bertagnoli figure 3) can pass through the apertures. This allows proper alignment of the assembly on the spine (paragraph 5). It would have been obvious to one skilled in the art at the time the invention was made to construct the invention of Bertagnoli, including an alignment guide in view of Kim in order to have proper alignment of the assembly on the spine.

In regards to claim 11 Bertagnoli discloses the claimed invention except for having a measurement instrument. Kim discloses a distractor device with a measurement instrument which allows the user to measure between two points. It would have been obvious to one skilled in the art at the time the invention was made to construct the invention of Bertagnoli, including a measurement instrument in view of Kim in order to have the measurement between two points. .

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Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bertangnoli (US Pat App Pub 2005/0021040) (in the IDS) in view of Michelson (US Pat App Pub 2002/0058944).

Bertangnoli discloses the claimed invention except for having a shaping instrument. Michelson discloses a shaping instrument (100) that provides a space for a disc. It would have been obvious to one skilled in the art at the time the invention was made to construct the invention of Bertangnoli, including a shaping instrument in view of Michelson in order to make a space for the disc.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bertangnoli (US Pat App Pub 2005/0021040) (in the IDS) and Kim (US Pat App Pub 2003/0055430) (in the IDS) as applied to claim 22 above, and further in view of Michelson (US Pat App Pub 2002/0058944).

The combination of Bertangnoli and Kim discloses the claimed invention except for having a shaping instrument. Michelson discloses a shaping instrument (100) that provides a space for a disc. It would have been obvious to one skilled in the art at the time the invention was made to construct the combination of Bertangnoli as modified by Kim, including a shaping instrument in view of Michelson in order to make a space for the disc.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art cited of interest.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kim whose telephone number is (571) 272-2817. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JK 


EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER